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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,990	11/21/2003	Alan Howe	421/73/2	1736

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EXAMINER

FETTEROLF, BRANDON J

ART UNIT PAPER NUMBER

1642

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,990

Applicant(s)

HOWE, ALAN

Examiner

Brandon J. Fetterolf, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

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Howe, Alan

Pending Claims: 1-38

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14 and 36-38, as specifically drawn to a phosphoprotein detection reagent and a method of making the phosphoprotein detection reagent, classified in class 530, subclass 352.
- II. Claims 15-28, as specifically drawn to a method of detecting a phosphoprotein, classified in class 435, subclass 4.
- III. Claims 29-35, as specifically drawn to a method for early diagnosis of a change in state of a target tissue, comprising detecting a change in the phosphorylation status of a protein present within a target tissue in response to a change in the status, classified in class 436, subclass 64.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups II-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the specification does not disclose that their methods would be used together. The method for detecting a phosphoprotein (Group II) and the method for early diagnosis of a change in state of a target tissue (Group III) are unrelated as they comprise distinct steps and utilize different products which demonstrates that each method has a different mode of operation. Each invention performs

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this function using structurally and functionally divergent material. Moreover, the methodology and materials necessary for detection and diagnosis differ significantly for each of the materials. For detecting a polyphosphoprotein, a protein-containing solution may be used. For diagnosing, a protein lysate from a cell from the target tissue may be used. Therefore, each invention is divergent in materials and steps. For these reasons the inventions of Groups II-III are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. The inventions of Groups II-III have a separate status in the art as shown by their different classifications. As such, it would be burdensome to search the inventions of Groups II-III.

The invention of Group I and the inventions of Groups II-III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as for detecting a phosphoprotein or for diagnosing a change in a state of a target tissue.

Because the inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for other groups because each group requires a different non-patent literature search due to each group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

### ***Species Election***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Claim 5 (Group I) is generic to a plurality of disclosed patentably distinct species comprising the following metal ions:  $\text{Fe}^{3+}$ ,  $\text{Cu}^{2+}$ ,  $\text{Al}^{3+}$ ,  $\text{Yb}^{3+}$ ,  $\text{Zn}^{2+}$ ,  $\text{Ni}^{2+}$ ,  $\text{Co}^{2+}$ , and  $\text{Ga}^{3+}$  which differ at least in chemical property (*see periodic table*, ChemGlobe 2000) such that one species could not be

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interchanged by another. As such, each species would require different searches and the consideration of different patentability issues.

Claim 11 (Group I) is generic to a plurality of disclosed patentably distinct species comprising the following chelator donor molecules: 2-(aminooxyethyl)iminodiacetic acid (AIDA), aminobutyl-nitroacetic acid (AB-NTA), and iminodiacetic acid (IDA) which differ at least in chemical structure such that one species could not be interchanged by another. As such, each species would require different searches and the consideration of different patentability issues.

Claim 12 (Group I) is generic to a plurality of disclosed patentably distinct species comprising the following detectable moiety donors: sulfo-N-hydroxysuccinimidyl-biotin (sulfo-NHS-biotin), sulfosuccinimidyl-6-(biotinamido) hexanoate (sulfo-NHS-LC-biotin), sulfosuccinimidyl-6-(biotinamido)-6-hexanimido hexanoate (sulfo-NHS-LC-LC-biotin), and penta-fluorophenyl-biotin which differ at least in chemical structure and chemical/physical properties such that one species could not be interchanged by another. As such, each species would require different searches and the consideration of different patentability issues.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Note:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

**Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Fetterolf, PhD whose telephone number is (571)-272-2919. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brandon J Fetterolf, PhD  
Examiner  
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BF

A handwritten signature in black ink, appearing to read "Gary Nickol", with a stylized flourish at the end.

**GARY NICKOL**  
**PRIMARY EXAMINER**